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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,581	10/23/2003	Yu-Cheng Sheng	0021157-0027	1088
23600	7590	01/14/2005	EXAMINER	
COUDERT BROTHERS LLP 333 SOUTH HOPE STREET 23RD FLOOR LOS ANGELES, CA 90071			TREMBLAY, MARK STEPHEN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,581	Applicant(s) SHENG, YU-CHENG	
	Examiner Mark Tremblay	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. § 103 as being unpatentable over the Epson Perfection 1200 Color Flatbed Scanner ("Perfection" hereinafter) in view of "i/oZone Products for the week of March 3, 2003" ("Zone" hereinafter). Perfection is cited for teaching a flatbed, stand alone scanner with a USB port. Perfection does not teach a USB host controller. Zone teaches that Cypress's next-gen chip will allow "cell phones, PDAs, printers, cameras and music players" to "connect to each other without the need for a host computer". Since cameras take pictures, and Scanners take pictures of paper, there are analogous reasons for wanting to print them out. Since the scanner is often connected to a printer via a USB port connected to a computer, it is again analogous to a camera. The CY7C67300 allows a stand alone scanner to connect directly to a stand-alone printer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Cypress CY7C67300 to connect a stand alone scanner to a stand alone printer, because such an arrangement would allow the two to connect without the need for a computer. This seems to be the directly envisioned use of the chip.

Re claims 4-6, these are also clearly envisioned, since they were also interfaced via USB at the time the chip was made.

Re claim 8, power supplies were old and well known at the time the invention was made. Since USB scanners often got their power from a host

computer via the USB plug, it must replace the power. This would have been obvious to one having ordinary skill in the art.

Response to Arguments

Applicant argues that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion in the prior art to make the claimed combination. The Examiner respectfully disagrees. The Applicant points out that the best mode of making and using the invention involves the Cypress controller. The description of this embedded USB host controller clearly contains the suggestion to use it with USB peripheral devices including "cell phones, PDAs, printers, cameras and music players" to "connect to each other without the need for a host computer", as pointed out previously. This list is clearly exemplary of USB peripherals, not exhaustive. From the point of view of the writer of the description of the Cypress controller, an exhaustive list would clearly burden the reader, and would be inappropriate. Thus, the skilled artisan is informed that all known peripherals having USB ports can be connected together by using the new Cypress controller, based on the examples given.

Applicant argues that because the Cypress description fails to explicitly mention a scanner, the Examiner relied on hindsight analysis, and should withdraw the rejection. Examiner agrees that Cypress fails to expressly recite a "scanner" and that Examiner's analysis is based on hindsight analysis (as are necessarily all 35 USC 103 rejections). The question is whether it is improper hindsight. Since the rejection is based on the analogy between cameras and scanners, the Examiner finds this not to be the improper type of hindsight.

Applicant argues that because the Zone publication failed to specifically mention a scanner, but mentioned other USB peripherals, the publication teaches away from Applicant's invention. The Examiner respectfully disagrees. Again, the skilled artisan would not understand the Zone article to contain an exhaustive list. Nothing in the Zone article suggests an exhaustive list. In fact, the

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Zone article seems to be quoting directly from Cypress materials; compare the Zone lists with the list found at page 11 of "CY3663 Hardware Users Manual, Version 1.5". In the latter list, the list is introduced by the phrase "applications such as:".

Applicant asserts that the Zone publication does not disclose "a second port adapted to communicate with another peripheral device." Examiner respectfully disagrees. Zone clearly refers to "multi-port" host/peripheral applications and "up to four ports".

Applicant asserts that the peripherals mentioned in claims 4-6 are not suggested by the Zone publication. Examiner respectfully disagrees. Zone expressly recites a "DVD" player which is a type of media storage device. Zone expressly recites a "cell phone" which is a network interface. Zone expressly recites an MP3 player, which *typically* comprised at the time the invention was made a "memory card reader".

Applicant argues that the rejection of claim 8 fails because the Office Action cites no prior art which teaches a scanner that was powered from a host computer via a USB plug. Examiner will interpret this as a traversal of the Examiners Official Notice that USB scanners often got their power from USB cords, and a request for a document. Examiner has cited a review of the Artec 1236 USB scanner from 1999. This was a commercially available and popular scanner, and its lack of power cord was well known in the art. The USB specification itself was aimed at providing a limited amount of power to peripherals, to avoid the need for a power supply. If Applicant were to review the literature concerning the USB specification, or examine a USB mouse or keyboard, Applicant could easily ascertain this to be the case. In fact, the '200 is designed to be easy on batteries (page 2 of the Zone publication).

Conclusion

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (571) 272-2408. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (571) 272-2398. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.



MARK TREMBLAY
PRIMARY EXAMINER

January 10, 2005